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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/326,020 06/04/99 PORTER

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EXAMINER

ROBINSON, B

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

04/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/326,020

Applicant(s)

Porter Et. Al.

Examiner

Binta Robinson

Group Art Unit

1625



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 12 is/are allowed.

☒ Claim(s) 1-11, 13, and 14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 8, and

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This application contains claims directed to the following patentably distinct species of the claimed invention: The species in claim 12, page 41.

Applicant is required under 35 U. S. C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, the compound of formula I is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit not the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U. S. C. 103(a) of the other invention.

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2. During a telephone conversation with David Cherry on April 13, 2000, a provisional election was made with traverse of a single disclosed species of example 11, page 28 to prosecute on the merits. Affirmation of this election must be made by applicant in replying to this Office action.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

4. Claims 1-11 and 13-14 are rejected on the grounds that the claims are drawn to an improper Markush group. In re Harnish, 206 USPQ 300, states that a unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility. In the instant case, the claimed subject matter does not share a substantial structural feature disclosed as being essential to that utility.

The requirement for a proper Markush claim is that it includes only substances that in their physical, chemical and physiological characteristics are functionally equivalent. The members of the instant Markush groups possess widely different, physical and chemical properties. The compounds are not considered functionally equivalent and are so diverse that they demonstrate dissimilar and unrelated properties. The mere fact that there is structural

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similarity in optical agents is not in itself reason to render all the embodiments functionally equivalent.

The improper Markush groups are R1, Alk1, r, L1, s, Alk2, R, R2, X1, and R4.

The examined subject matter is as follows: The compound of formula Ia in claim 1, page 40 of application, where R¹ is pyridyl or non heterocyclic rings, r is 0, s is 1, m is 1, R4 is anything, R2 is anything, R3 is anything, and R is CO₂H. Amending the claims to the elected subject matter would overcome the improper Markush rejection.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 8, 9, 10, 11 are rejected under Bolin et. al (Reference U).

Bolin teaches the instant compound, compound 18. At page 281, Table 1, see compound 18.

6. Claims 1-6, 8-11, and 13 are rejected under Cordell et. al (Reference N).

Cordell teaches the instant compound, RN 168633-23-6. At pages 1-132, see compound 168633-23-6.

7. Claims 1-11 are rejected under Okamoto et. Al. (Reference O).

Okamoto teaches the instant compound, RN 123443-57-2P. At pages 649-670, see compound, RN 123443-57-2P.

8. Claim 12 appears to be allowable.

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9. The elected species of example 11 on page 28 of the specification is allowable.
10. The Information Disclosure Statements (IDS) filed 7/19/1999, 11/22/99, 2/10/2000 and 2/15/2000 have been considered. Those references crossed out on the IDS have not been considered because they were not supplied along with the IDS. The crossed out references can only be considered when they are supplied with the IDS.
11. Any inquiry concerning this communication or earlier communications from the should be directed to Binta Robinson whose telephone number is (703)306-5437.

The examiner can normally be reached on Monday through Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. John Kight, can be reached on (703)308-0204. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

BMR

April 21, 2000


JOHN KIGHT
SUPERVISORY UNIT EXAMINER
GROUP 1200
1600